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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,652	08/07/2006	Katsuhiko Kageyama	11197/16	9247
23838 7590 09/14/2009 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER				
MESH, GENNADIY				
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1796				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/588,652

Applicant(s)

KAGEYAMA ET AL.

Examiner

GENNADIY MESH

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 12, 14-19 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 12, 14-19 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's Amendment filed on July 6, 2009 is acknowledged.

Claims 1-7, 9-11,13 and 20-23 have been cancelled. Claims 24 - 28 are newly added. Claims 8,12, 14-19 and 24-28 are pending. Claims 8, 12 and 14 have been amended. Support for amendment of claims has been found in original claims and Specification as it indicated by Applicant.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 8, 12, 14 - 19 and 24 - 28 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakajima et al.(WO 2001/014448 - note that EP 1 227 117)

Regarding Claims 8, 12, 14-19, 24 and 28 Nakajima"117" discloses polymerization catalyst for polyester and polyesters produced with this catalyst, wherein catalyst comprises (see [0016]), aluminum compound, for example, aluminum chloride (see [0017]), phosphorous compound, for example, phosphonic acid (see [0018]) and solvent, as ethylene glycol (see [0038]). Catalyst can be produced by mixing ingredients with following step of heat treating (see [0061]).

Thus, Nakajima meet all compositional and processing limitations as it required by Claims 8, 12, 14 - 19, 24 and 28.

For this reason, catalyst disclosed by Nakajima"117" inherently will poses same properties as it claimed by Applicant, including presence of same peaks at same positions in NMR spectra as it claimed in Claim 12.

Regarding Claims 25 - 27 : it is noted that claims 25-27 are in format of product-by-process claim. In accordance with the applicable to the treatment of product-by-process claims (MPEP 2113), the process limitations in claims 25-27 have no probative value absent evidence to the contrary.

In addition note, that case law holds that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

In light of the above, it is clear that Nakajima"117" anticipates the presently cited claims.

Alternatively, given that the final product appear to be the same, it would have been obvious to one of ordinary skill in the art to obtain the presently claimed product as a polymerization catalyst by different process.

3. Claims 8, 12, 14 - 19 and 24 - 28 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakajima

et al.(WO 2002/227070 - note that US Patent 7,132,383 used as English translation of WO 2002/227070).

Regarding Claims 8, 12, 14 - 19 and 24 - 28 Nakajima"383" discloses polymerization catalyst for polyester and polyesters produced with this catalyst, wherein catalyst comprises (see claim 1), aluminum compound, for example, aluminum chloride (see claim 2) and phosphorous compound (see claim 1).

Note, that specific phosphorus compound disclosed by Nakajima"383" in claim 1 (Formula 1) meet limitation of Applicant Claim 8, because it satisfied Applicant's definition of suitable phosphorous compounds as it provided in Specification (see Formula 1, paragraph [0077] of PG PUB US 2007/0106055).

Nakajima"383" further discloses that Catalyst can be produced by mixing ingredients with water and /or ethylene glycol (see column 8, lines 36 - 48) with following step of heat treating the mixture (see column 8, lines 36 - 48) .

Thus, Nakajima ' 383' meet all compositional and processing limitations as it required by Claims 8 - 19. For this reason, catalyst disclosed by Nakajima "383" inherently will poses same properties as it claimed by Applicant, including presence of same peaks at same positions in NMR spectra as it claimed in Claim 12 .

Regarding Claims 25 - 27 : it is noted that claims 25-27 are in format of product-by-process claim. In accordance with the applicable to the treatment of product-by-process claims (MPEP 2113), the process limitations in claims 25-27 have no probative value absent evidence to the contrary.

In addition note, that case law holds that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

In light of the above, it is clear that Nakajima '383' anticipates the presently cited claims.

Alternatively, given that the final product appear to be the same, it would have been obvious to one of ordinary skill in the art to obtain the presently claimed product as a polymerization catalyst by different process.

4. Claims 8, 12, 14-19, 24 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,132,383 as it explained in paragraph 3 above.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5.1 Claims 8, 12, 14-19, 24 and 28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7,132,383. Although the conflicting claims are not identical, they are not patentably distinct from each other as it was explained in paragraph 3 above.

5.2 Claims 8, 12, 14-19, 24 and 28 directed to an invention not patentably distinct from claims 1-15 of commonly assigned U.S. Patent No. 7,132,383 as it was shown above(see paragraph 4).

5.3. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 7,132,383, discussed above,

would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Response to Arguments

6. Applicant's arguments filed July 6, 2009 have been fully considered but they are not persuasive.

6.1. Applicant's arguments related to rejected claims based on statement that prior art does not disclose property of catalytic composition as NMR spectrum lines it fails anticipate Applicant's claimed subject matter.

However, applicant fails to present any evidence that same catalytic composition will not inherently poses specific properties as NMR spectrum.

Note, that case law holds that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705,709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Therefore, Applicant's arguments were found unpersuasive.

6.2. Obvious Double Patenting rejection is maintained for the record.

It is noted, that no arguments related to this rejection were presented by Applicant .

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GENNADIY MESH whose telephone number is (571)272-2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272 1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gennadiy Mesh
Examiner
Art Unit 1796

/GM/

/David Wu/
Supervisory Patent Examiner, Art Unit 1796